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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Thomas H. Baum, et al.	Group Art Unit: 2813
Application No.:	09/823,196	Examiner: E. Kielin
Filing Date:	March 30, 2001	
Title:	SOURCE REAGENT COMPOSITIONS FOR CVD FORMATION OF GATE DIELECTRIC THIN FILMS USING AMIDE PRECURSORS AND METHOD OF USING SAME	

EXPRESS MAIL
I hereby certify that this paper is being deposited this date with the U.S. Postal Service as Express Mail in an envelope addressed to Commissioner of Patents and Trademarks, Washington, DC 20231, under the provisions of 37 CFR 1.10.

Lee Ann DiLello

May 2, 2002
Date
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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner of Patents and Trademarks
Washington, DC 20231

Sir:

In response to the Office Action dated April 9, 2002 in the above-identified application, wherein a restriction requirement was imposed against the following claim groups:

I. Claims 1-40, drawn to a CVD precursor composition, classified in class 427, subclass 126.1;

II. Claims 41-68, drawn to a method of forming a dielectric on a substrate, classified in class 438, subclass 785;

III. Claims 69-78 drawn to a method of forming a gate dielectric, classifed in class 438, subclass 591; and

IV. Claims 79-85, drawn to a dielectric layer, classified in class 257, subclass 410.

applicants hereby elect, with traverse, the Group I claims 1-40; Species 1A.

Applicants' reasons for the traversal of the restriction requirement are set out below, and on such basis, applicants request the Examiner to reconsider his restriction of the pending claims, and to withdraw same in favor of consolidated examination and prosecution of claims 1-85 pending in the application.

An Examiner's authority to require restriction is defined and limited by statute:

> If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. 35 U.S.C. § 121, first sentence (emphasis added).

The implementing regulations of the Patent and Trademark Office include the mandate that restriction is appropriate only in cases presenting inventions, which are both independent and distinct, 37 C.F.R. §§1.141-142. Without independence and distinctness, a restriction requirement is unauthorized.

In the present application, the species which the Examiner has grouped separately are not "independent and distinct" so as to justify the restriction requirement. The Group I claims, 1-40, are directed to a CVD precursor composition, while Groups II and III, claims 41-78, are directed to a method of forming a dielectric film on a substrate using the precursors of claims 1-40. Finally, Group IV, claims 79-85, are directed to a dielectric layer made using the precursors and method of claim Groups I, II, and III..

The interdependence of these variations of precursors, methods and device is confirmed --indeed, it is mandated-- by virtue of the fact that the description requirements of 35 U.S.C. §112 compel disclosure of all three aspects of the invention in the one application, which Applicants have filed.

In addition, the courts have recognized that it is in the public interest to permit applicants to claim several aspects of their invention together in one application, as the applicants have done herein. The CCPA has observed:

> We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. §112 all aspects as to what they regard as their invention, regardless of the number of statutory classes involved. In re Kuehl, 456 F.2d 658, 666, 117 U.S.P.Q. 250, 256 (CCPA 1973).

This interest is consistent with the practical reality that a sufficiently detailed disclosure supporting claims to one aspect of an invention customarily is sufficient to support claims in the same application to other aspects of the invention.

Applicants respectfully suggest that in view of the continued increase of official fees and the potential limitation of an applicant's financial resources, a practice which arbitrarily imposes restriction requirements may become prohibitive and thereby contravene the constitutional purpose to promote and encourage the progress of science and the useful arts.

It is vital to all applicants that restriction requirements issue only with the proper statutory authorization, because patents issuing on divisional applications, which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double patenting. The third sentence of 35 U.S.C. §121, which states that a patent issuing on a parent application "shall not be used as a reference" against a divisional application or a patent issued thereon, does not provide

comfort to applicants against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that §121 protects a patentee from an allegation of same-invention double patenting, Studiengesellschaft Kohle mbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 228 U.S.P.Q. 837, 840 (Fed. Cir. 1986); and in Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990) that court held that §121 does not insulate a patentee from an allegation of "obviousness-type" double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of patent on the divisional application.

All these considerations indicate that the imposition of a restriction requirement with inadequate authority can lead to situations in which an applicant's legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect a patentee's rights and to serve the public's interest, the Examiner is not to require restriction in cases such as the present application wherein various aspects of a unitary invention are claimed.

For the above reasons, Applicants respectfully request that the Examiner withdraw the restriction requirement and examine all of the aspects of the present invention as the unitary invention that it is. In the alternative, the Applicants request that the Examiner withdraw the restriction requirement, and redesignate claims 1-85 as a single group.

Applicant does not believe that any fee is due in connection with the foregoing. However, any deficiencies may be charged to the deposit account 50-0860

Respectfully submitted,

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